

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

REMARKS/ARGUMENTS

The Examiner is thanked for the Final Official Action dated May 3, 2007. This request for reconsideration is intended to be fully responsive thereto.

Claims 1-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yu (US 5190258) in view of Meisner et al. (US 5675426). The applicant respectfully disagrees.

Regarding claim 1: The examiner alleges in his response to applicant's arguments that the recitation "an audio accessory system" has not been given patentable weight because the recitation occurs in the preamble, and cites, among others *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

First, as noted in *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), "The preamble is therefore not merely a statement of effect that may or may not be desired or appreciated." As clearly stated in MPEP 2112.02, "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." (Emphasis added).

Incidentally, in the *Kropa v. Robie*, cited by the examiner, "a preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.)" (see MPEP 2112.02) (Emphasis added). Equally, not every combination of elements capable *inter alia* of use as speakers, a common backing panel and a base unit is not an "audio accessory system. Therefore, the preamble of claim 1 serves to further define the structure of the audio accessory system of the present invention.

Second, as stated in *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), "In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose." Similarly, the recitation in claim 1 of "a portable electronic device" gives life and meaning to the preamble's statement of purpose. Also, claim 1 recites "said base unit having at least one plug-in device to communicate with said portable electronic device." (Emphasis added). As the preamble adds limitation to those in the body of the claim, the preamble is itself a claim limitation and is relevant to proper construction of the claim.

Moreover, as stated in MPEP 2111.02.I., "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966

Appl. No. 10/631,016

In re HUSSAINI, et al.

Reply to Final Office Action of May 3, 2007

(Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar*>; < however>, < the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. “[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited.” (Emphasis added) Id. at 1073, 828 F.2d at 754.).” In other words, the teachings of the prior art, against which patentability of claim 1 should be measured, is not all audio accessory systems broadly, but audio accessory systems suitable for use in a portable electronic device, for the claims are so limited.

As further stated in MPEP 2111.02.II regarding *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), “In a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia."² Similarly, claim 1 should be is properly interpreted to mean that the audio accessory system is for use with a portable electronic device only."

Thus, the preamble to claim 1 clearly recites distinct definition of the claimed invention's limitations, i.e. the audio accessory system for use with a portable electronic device. In other words, the audio system of the present invention is an accessory, i.e. "a subordinate or supplementary part or object that adds to convenience, attractiveness, safety, etc." and is provided for use specifically with a portable electronic device, not any electronic device. Accordingly, the preamble limits the structure of the claimed invention and must be treated as a claim limitation.

The examiner further erroneously alleges that Yu discloses an audio accessory system (including frame 22 and speakers 15, 15A) for use with a portable electronic device (such as a laptop computer, DVD player, or video game). In fact, Yu discloses a multimedia personal computer includes a keyboard 10 and a monitor 11 with a display screen 12 mounted on an amplifier 13 of an audio system (see column 2, lines 47-50). Clearly, those skilled in the art would readily realize that the amplifier 13 is in fact an electronic processing unit of the desk

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

top personal computer (see Fig. 1 of Yu), which is not defined in the art as portable.

While recognizing that the pending claims must be given their broadest reasonable interpretation consistent with the specification, we trust that that the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach, as stated in MPEP § 2111. Also, the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. MPEP § 2111.01.

First, those skilled in the art would not possibly interpret the frame 22 and speakers 15, 15A of Yu as the audio accessory system. The plain meaning of the word “accessory”, as defined by the Random-House Webster’s College Dictionary (1999 Second Random House Edition), is “a subordinate or supplementary part or object that adds to convenience, attractiveness, safety, etc.” In other words, accessories are designed to be attached to the intended product without any modification of that product, and no element of the accessory system for use with a portable electronic device can be inserted in to become part of the portable electronic device. By contrast, the frame 22 of Yu (supporting the speakers 15, 15A) cannot be inserted in and becomes part of the housing of any portable electronic device (such as a laptop computer, DVD player, or video game). Clearly, the electronic device must be specifically design to have special openings in its housing (as shown in Fig. 1 of Yu) to receive arms 27 of the frame 22. Therefore, the frame 22 and speakers 15, 15A of Yu cannot possibly be interpreted as an audio accessory system. Contrary to the examiner’s allegations, the audio

system (frame 22 and speakers 15, 15A) is an integral part of the permanent fixture to the multimedia personal computer of Yu (not an accessory).

Second, the examiner erroneously interpreted the support structure of the amplifier 13 of Yu (apparently the hollow housing of the amplifier 13) as a single common backing panel, while the electronics of the amplifier 13 were interpreted as a base unit. The plain meaning of the word “panel”, as defined by the Random-House Webster’s College Dictionary (1999 Second Random House Edition), is “a comparatively thin, flat piece of wood or the like.” Clearly, those skilled in the art would not possibly interpreter the hollow housing of the amplifier 13 as the panel, i.e. “a comparatively thin, flat piece of wood or the like.”, and the electronics of the amplifier 13 as a “base unit”.

Also, if the amplifier 13 is interpreted the backing panel, then Yu fails to disclose the portable electronic device and at least one plug-in device to communicate with the portable electronic device.

The examiner also alleges that the meaning of portability is very broad. The examiner noted that “it is the examiner’s stance that modern day desktop computers are very portable”. In other words, the examiner implicitly concedes that Yu disclose the desktop computer, not the portable electronic device.

Regarding the examiner’s remarks on the meaning of portability: those skilled in the art would readily recognize that in electronics the portable electronic devices are defined as devices that are wearable or handheld, designed to be moved from one place to another, and

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

devices that allow the user to utilize them while being mobile. Although the contemporary desktop computers (or almost any other electronic devices, such as TV sets, DVD players, etc.) could be moved from one deck to another, clearly they are not wearable or handheld, not designed to be moved from one place to another, and do not allow the user to utilize them while being mobile. Thus, the electronic devices of Yu and Meisner cannot possibly be interpreted as portable.

Therefore, Yu fails to disclose almost all elements recited in claim 1, including the audio accessory system, the portable electronic device, the single common backing panel, and the base unit having at least one plug-in device to communicate with the portable electronic device.

The examiner concedes that Yu does not expressly disclose a base unit being rotatably mounted to a backing panel and further cites the patent Meisner disclosing a television monitor (cabinet) 10 and right and left sets of speakers rotatably mounted to the cabinet 10. The examiner erroneously interprets the monitor (cabinet) 10 as a single common backing panel (as recited in claim 1), and a stand 11 of the monitor (cabinet) 10 as a base unit of the audio accessory system. However, the examiner does not interpret the doors 13 and 17 with speakers of the TV monitor 10 as an audio accessory system, as the doors 13 and 17 are integral part of the TV monitor 10.

Again, as argued above, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach (see MPEP §

2111). Also, the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. MPEP § 2111.01. The examiner's interpretation of the claims is not consistent with the specification and contradicts the plain meaning of the words of the claim 1. Moreover, the examiner's interpretation of the claims is not consistent with the interpretation that those skilled in the art would reach. Specifically, those skilled in the art would not possibly interpret the TV monitor (cabinet) 10 as the single common backing panel which, by definition, is "a comparatively thin, flat piece of wood or the like."

The examiner alleges that it would have been obvious to a person of ordinary skill in the art to use the speaker placement of Meisner with the system of Yu to automatically turn the speakers toward the user when the screen is turned.

First, as neither Yu nor Meisner discloses the audio accessory system, even if the combination of and modification of Yu and Meisner suggested by the Examiner could be made, the resulting device would not be the audio accessory system.

Second, those skilled in the art would readily realize that the TV monitor 10 is not a backing panel of the audio accessory system, but a main component of the electronic device of Meisner, which is not defined in the art as portable. Moreover, the stand 11 of the monitor (cabinet) 10 cannot be interpreted as a base of the audio accessory system, as the stand 11 lacks any plug-in device to communicate with the electronic device (the monitor 10).

The examiner argued the test is what the combined teachings of the references would

have suggested to those of ordinary skill in the art. Clearly, as neither Yu nor Meisner discloses the base unit, as recited in claim 1, the combined teachings of the references would not have suggested to those of ordinary skill in the art to provide the stand 11 of Meisner with the plug-in device as the speakers of Meisner are integrally formed with the TV monitor 10, thus the TV monitor 10 is not designed to be connected to the audio accessory system. Thus, even if the combination of and modification of Yu and Meisner suggested by the Examiner could be made, the resulting audio system still would lack speakers rotatably mounted to a single common backing panel, in turn rotatably mounted to a base unit having at least one plug-in device to communicate with a portable electronic device.

Therefore, the rejection of claim 1 under 35 U.S.C. 103(a) over Yu and Meisner is improper.

Claims 2-14 depend upon the base claim 1 and introduce additional limitations further defining the present invention over the prior art.

Further regarding claims 3 and 4: In addition to the above arguments regarding the patentability of claim 1 and contrary to the examiner's allegations, Yu fails to disclose the base unit having one or more pass-through ports. The pass-through port recited in claims 3 and 4 provides an intermediate connection between the portable electronic device and an auxiliary accessory while the audio accessory is connected to the portable electronic device. In other words, the base unit of the present invention has at least two ports: the plug-in port (device) connecting the base unit to the portable electronic device, and the pass-through port

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

connecting the base unit to the auxiliary accessory. Clearly, the amplifier 13 of Yu lacks not only the plug-in port connecting the amplifier 13 to the portable electronic device, but also the pass-through port connecting the amplifier 13 to the auxiliary accessory. Moreover, contrary to the present invention, as recited in claim 3, the input and speaker output terminals on the amplifier 13 of Yu are provided for connecting the speakers 15 and 15A to the amplifier 13, but cannot provide communication between the amplifier 13 and a separate auxiliary accessory. Accordingly, the rejection of claims 3 and 4 under 35 U.S.C. 103(a) over Yu and Meisner is improper.

Further regarding claim 14: In addition to the above arguments regarding the patentability of claim 1 and as conceded by the examiner, Yu fails to disclose locking tabs on the base unit for engaging the portable electronic device to ensure that the system remains connected to the portable electronic device. As neither Yu nor Meisner discloses the base unit of the audio accessory system and the portable electronic device, even if the combination of and modification of Yu and Meisner suggested by the Examiner could be made, the resulting device would still lack the locking tabs on the base unit for engaging the portable electronic device. Accordingly, the rejection of claim 13 under 35 U.S.C. 103(a) over Yu and Meisner is improper.

Regarding claim 15: All the above arguments regarding the patentability of claim 1, are equally applicable to claim 15.

Specifically, those skilled in the art would readily realize that the TV monitor 10 is not a backing panel of the speaker system, but a main component of the electronic device of Meisner, which is not defined in the art as portable. Moreover, the stand 11 of the TV monitor 10 cannot be interpreted as a base of the speaker system, as the stand 11 lacks any plug-in device to communicate with the electronic device (the monitor 10). Thus, even if the combination of and modification of Yu and Meisner suggested by the Examiner could be made, the resulting speaker system still would lack speakers rotatably mounted to a single common backing panel, in turn rotatably mounted to a base unit having two plug-in device to communicate with a video amusement device. In addition, the prior art fails to disclose the speaker system having an installed locking position and a stored locking position, and at least two pass-through ports wherein similar or identical electronic devices or auxiliary accessories can be attached.

Moreover, contrary to the present invention, as recited in claim 15, the input and speaker output terminals on the amplifier 13 of Yu are provided for connecting the speakers 15 and 15A to the amplifier 13, but similar or identical electronic devices or auxiliary accessories cannot be attached thereto. Moreover, the erroneously examiner alleges that the system (i.e. the multimedia personal compute) of Yu an installed locking position (full forward) and a stored locking position (full backward). Clearly, those skilled in the art would realize that the multimedia personal computer of Yu, being the desktop computer, any installed or stored locking positions. The full forward or full backward positions of the

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

multimedia personal computer of Yu are merely different adjustable positions. Moreover, Yu lacks any disclosure of the stored locking position of the multimedia personal computer or any of its components.

Therefore, the rejection of claim 15 under 35 U.S.C. 103(a) over Yu and Meisner is improper.

Claims 16-24 depend upon the base claims 15 and introduce additional limitations further defining the present invention over the prior art.

Further Regarding claims 5 and 16: In addition to the above arguments regarding the patentability of claims 1 and 15, Yu fails to disclose the speakers have an extreme vertical position that is perpendicular to the backing panel, and an extreme lateral position that is axially aligned with the backing panel. Contrary to the examiner's allegations, the speakers of Yu cannot be placed in the extreme lateral position (90 degrees from figure 8) that is axially aligned with the amplifier 13. As clearly illustrated in Figs. 9A, the rotation of the speaker 15 is restricted to the angle of 15° in the vertical direction by the arm 27. Thus, the speakers of Yu cannot be placed in the extreme lateral position (90 degrees from figure 8) that is axially aligned with the amplifier 13.

Further Regarding claims 8 and 20: In addition to the above arguments regarding the patentability of claims 1 and 15, Yu fails to disclose the arrangement wherein the system is changed from the installed position to the stored position by rotating the speakers and the backing panel in excess of one hundred eighty degrees. The examiner concedes that Yu fails

to disclose a range of motion of greater than one hundred eighty degrees. However, the examiner alleges that it would have been obvious to have frame 22 of Yu have recesses 23 that allow for greater range of motion in order to allow for a greater number of possibilities in speaker and listener positions. The examiner's alleged motivation is not convincing, as being the desktop computer, the monitor 11 of the multimedia personal computer of Yu is always in front of the user on the work desk, and thus the user needs only limited adjustability of the speakers 15, 15A.

The examiner also alleges that although ideally users are usually sitting directly in front of a monitor, this is not always the case. There are cases where there are multiple users. Applicant respectfully disagrees. Those skilled in the art would realize that as the desktop computer of Yu has only one keyboard, only one user at a time utilizes the computer.

Further Regarding claims 12 and 19: In addition to the above arguments regarding the patentability of claims 1 and 15, Yu fails to disclose the speakers and the backing panel disposed underneath the portable electronic device in the stored position. The examiner concedes that the prior art fails to disclose this particular limitation of claim 12. However, the examiner takes official notice that it is general knowledge that people may place items on top of video monitors for unit placement. The motivation would have been to save space or to save time in unit placement. Opposite to the examiner's official notice, claim 12 recites the speakers and the backing panel disposed underneath the portable electronic device, not on top of video monitors. Moreover, while generally agreeing with the examiner that people may

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

place items on top of video monitors for unit placement, applicant is not aware of folding the speakers over the top of video monitors in the stored position.

Further Regarding claims 13 and 23: In addition to the above arguments regarding the patentability of claims 12 and 15, Yu fails to disclose the speakers that rotate in a plane perpendicular to a plane of rotation of the base unit. The examiner alleges that Yu discloses wherein said speakers rotate in a plane perpendicular (vertical) to the base unit plane of rotation (horizontal). However, the amplifier 13 of Yu (interpreted by the examiner as the base unit) is not rotatable, thus has no plane of rotation. Thus, the rejection of claim 13 under 35 U.S.C. 103(a) over Yu and Meisner is improper.

Further Regarding claims 14 and 24: In addition to the above arguments regarding the patentability of claims 1 and 15, Yu fails to disclose locking tabs on the base unit for engaging the portable electronic device to ensure that the system remains connected to the portable electronic device.

The examiner concedes that the prior art fails to disclose this particular limitation of claim 14. However, the examiner alleges it would have been obvious to one of ordinary skill in the art to further comprise locking tabs on the base unit, the tabs engaging the portable electronic device to ensure that said system remains connected to the portable electronic device. The examiner further alleges that the motivation to do so would have been to protect the units from damage and insure the unit does not get disconnected. To follow the examiner's line of

Appl. No. 10/631,016
In re HUSSAINI, et al.
Reply to Final Office Action of May 3, 2007

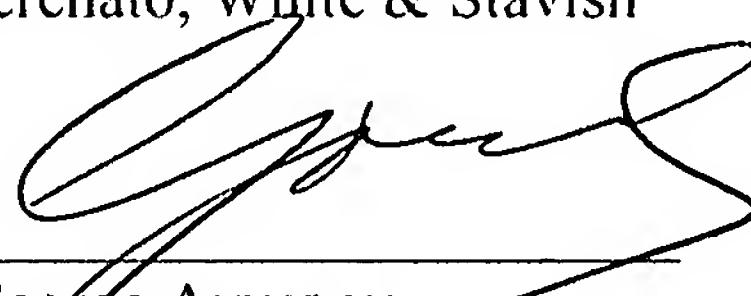
reasoning, the amplifier 13 of Yu (interpreted by the examiner as the base unit) should have the locking tabs to engage the keyboard 10 (to protect from damage and insure the keyboard does not get disconnected).

Thus, the examiner's alleged motivation is not convincing, as being the desktop computer (not portable), the amplifier 13 of the multimedia personal computer of Yu is securely disposed on the work desk does not need locking tabs to "protect the units from damage and insure the unit does not get disconnected", and "to ensure that said system remains connected to said portable electronic device."

It is respectfully submitted that claims 1-24 define the invention over the prior art of record and are in condition for allowance, and notice to that effect is earnestly solicited. Should the Examiner believe further discussion regarding the above claim language would expedite prosecution they are invited to contact the undersigned at the number listed below.

Respectfully submitted:
Berenato, White & Stavish

By:


George Ayvazov
Reg. N° 37,483

6550 Rock Spring Drive, Suite 240
Bethesda, Maryland 20817
Tel. (301) 896-0600
Fax (301) 896-0607